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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,549	10/04/2000	Rois O. Cordova	INTL-0473-US(P10020)	5766

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT PAPER NUMBER

2153

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/678,549

Applicant(s)

CORDOVA, ROIS O.

Examiner

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to remarks filed December 03, 2004. Claims 1-26 are presented for further consideration.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- In considering claims 1-26, all of the independent claims 1, 11, and 21 include limitations that were not described in the specification at the time the application was filed. The claims 1, 11, and 21 each recite, *inter alia*, “forwarding a software package including instructions to install the software package” The specification is silent to the software package including instructions to install, in particular; the specification does not even mention the term “instructions”. The specification does not describe the claimed limitation, therefore the Examiner concludes that the applicant did not have possession of the claimed invention including the limitation at the time the invention was filed.

Nonetheless, the limitation must be cancelled from the application or appropriately corrected.

- The claims 1, 11, and 21 each recite, *inter alia*, enabling the first processor-based system to automatically install the package and automatically forward the software package”. The specification does not describe or mention in any way automatically installing or automatically forwarding the software package. In particular, the specification does not even mention the term “automatically”. The specification states on page 3, lines 20-25 that the software is distributed to clients **that** install the software and then distribute a copy of the software, together with a list of addresses, to two additional clients. This disclosure does not describe automatically installing or forwarding the software package, therefore the Examiner concludes that the applicant did not have possession of the claimed invention including the limitation at the time the invention was filed. Nonetheless, the limitation must be cancelled from the application or appropriately corrected.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5-6, 9-11, 15-16, and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shepherd in view of Gilbert (U.S. Patent No. 5,850,396) in further view of Slivka et al. (U.S. Patent No. 6,256,668)

In considering claims 1, 11, 21, and 25, Shepherd discloses a system and method for distributing software to a plurality of automated teller machines the system comprises:

forwarding a software package and a list of addresses to a first processor-based system; (col. 3, lines 35-41); and

enabling said first processor-based system to automatically install said package and automatically forward said software package together with at least part of said list of addresses to a second processor-based system, said second processor-based system being on said list of addresses (col. 3, lines 43-58).

While Shepherd discloses the invention substantially as claimed Shepherd does not particularly disclose the destination (which identifies a terminal that is to receive the software package) including a list of addresses. Including a list of addresses or nodes in a forwarded data package, indicative the package's recipients, is well known in the art as evidenced by Gilbert. In similar Gilbert discloses a system for multicast message distribution wherein the network has an originating node that sends a message for ultimate receipt by a subset of nodes in a polynomial expansion manner. The originating node sends a message to a limited number of nodes; each node also receives a unique list of other nodes that should ultimately receive the message. Each of these other nodes then sends the message to one or more nodes on its list, along with a unique subset of nodes that still have not received the message (see Gilbert col. 5, lines 19-23).

Given the teachings of Gilbert, it would have been obvious to a person having ordinary skill in the art to modify the software distributing system disclosed by shepherd to include the unique node list as taught by Gilbert so that the software package can be sent from the originating node or processor-based system without having to incur substantial connect-time,

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thus allowing the software packages to be received in the most time-efficient manner that is possible. Therefore the aforementioned limitations would have been an obvious modification to the system disclosed by Shepard.

Additionally, Shepard fails to disclose that the software package includes instructions to install the software package. Nonetheless, a software package including an executable file containing installation instructions or setup instructions i.e. install.exe or steup.exe that executes and installs the software without user input is well known in the art as evidenced by Slivka. In similar art Slivka discloses that an extractor in the self-extracting executable file extracts and decompresses all file including the installation file i.e. setup.exe, and automatically starts the installation program (see Slivka col. 18, lines 62-67). A person having ordinary skill in the art would have readily recognized the advantages of including an executable file containing setup or installation instructions that will automatically install in order to reduce the incidence of user related installation problems. Therefore, the claimed limitation would have been obvious.

In considering claims 5 and 15, while Shepherd further discloses forwarding a transfer complete message to the management station to advise the management station that the software package has been transmitted to the specified terminal (col. 3, lines 59-67), Shepherd does not disclose sending the software package together with a checksum to enable the second processor-based system to confirm with the first processor-based system that the software package was received correctly. Nonetheless, the method of receipt confirmation is merely a design choice and would not change the overall functionality of the system. It would have been obvious to a person having ordinary skill in the art to include sending the software package along with a checksum to confirm that the software package was received correctly as an alternate delivery

confirmation method. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by Shepherd.

In considering claims 6 and 16, Shepherd further discloses including causing said first processor-based system to forward said software package to said second and a third processor-based system (col. 4, lines 43-51).

In considering claims 9 and 19, Shepherd further discloses transferring said software package together with software that enables said second processor-based system to transfer said software package to a third processor-based system (col. 4, lines 20-27).

In considering claims 10 and 20, Shepherd further discloses enabling said first processor-based system to forward said software package to said second processor-based/ system during a low activity time on said first processor-based system (col. 4, line 28-42).

In considering claims 22, Shepherd further discloses a system wherein the device is a server. (While Shepherd does not refer to the device 12 of fig 1, as a server; it performs all of the functions of a server and is therefore functionally equivalent to a server).

In considering claims 23, Shepherd further discloses wherein said server is a network management server (see fig. 1, means (12)).

In considering claims 24, Shepherd further discloses wherein said device is a client (see fig. 1, means (16-1-n)).

In considering claim 26, although the combined system of Shepard, Gilbert, and Slivka discloses the system substantially as claimed it does not disclose enabling the first processor-based system to automatically delete its address from the list of addresses before forwarding said list to said second processor-based system. Nonetheless, the aforementioned limitation would

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have been an obvious modification the to the combined system. It would have been obvious to a person having ordinary skill in the art to include the step of to automatically delete its address from the list of addresses before forwarding said list to said second processor-based system in order to avoid receiving the software package multiple time thus reducing unnecessary system processing time. Therefore the claimed limitation would have been an obvious modification to the combined system of Shepard, Gilbert, and Slivka.

6. Claims 2-4, 7-8, 12-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shepard in view of Gilbert in further view of Mapson (WO 98/33296).

In considering claims 7-8, and 17-18, while the combined system of Shepherd and Gilbert discloses the system substantially as claimed, the system does not disclose the step of encrypting the software package for transmission between said first and second processor-based systems and changing the encryption in a known fashion with each successive transfer from one to the next processor-based system. Nonetheless, encrypting software packages and changing the encryption with each transfer of the software was well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Mapson.

In similar art, Mapson discloses a distribution system with authentication that provides a method of distributing one or more copies of goods and/or services wherein the Integrity Check Value (ICV) is recalculated in a manner determinable from both the first location and the product. The product, including the recalculated ICV; is then distributed to a second location remote from the first location where the IVC of the distributed product is compared to the IVC known to the first location (see Mapson, page 1, lines 30-32; through page 2, lines 1-9).

Therefore, one of ordinary skill in the art would have found it obvious to incorporate and



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implement the recalculated ICV in Shepherd's system in order to ensure the integrity of software distributed over an at least partially insecure network.

In considering claims 2 and 12, Mapson further discloses enabling said first processor-based system to install said software package on said first processor-based system, make a copy of said software package, and transmit said software package to said second processor-based system (see Mapson, page 2, lines 7-8).

In considering claims 3 and 13, Mapson further discloses causing said first processor-based system to automatically authenticate said software package (see Mapson, page 4, lines 31-32 through page 5, lines 1-2 and 15-16).

In considering claims 4 and 14, Mapson further discloses causing said second processor-based system to automatically authenticate said software package by sending a message to said first processor-based system (see Mapson, page 8, lines 23-29).

### ***Response to Arguments***

7. In view of the Applicant's arguments with respect to claims 1-26, have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 571-272-3954. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

((703) 872-93068, for After Final communications

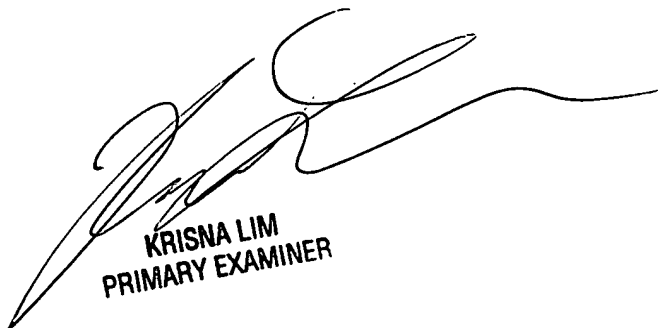
(703) 746-7239, for Official communications

(703) 746-7240, for Non-Official/Drafts.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571-272-3607).

Kimberly D Flynn  
Examiner  
Art Unit 2153

KF  
April 11, 2005



KRISNA LIM  
PRIMARY EXAMINER